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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/581,817 | 05/14/2007 | Markus Hoffmeister | 10191/4451 | 7185 |
| 26646 | 7590 | 11/29/2007 | | |
| KENYON & KENYON LLP ONE BROADWAY NEW YORK, NY 10004 | | | EXAMINER DUONG, DIEU HIEN | |
| | | | ART UNIT | PAPER NUMBER |
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| | | | 11/29/2007 | PAPER |

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/581,817

Applicant(s)

HOFFMEISTER ET AL.

Examiner

Dieu Hien T. Duong

Art Unit

2821

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 03 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06/02/06, 05/14/07.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 11-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 11-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 02 June 2006 is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date <u>08/15/07, 06/02/06</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Status of Application

1. This Office Action is a response to Applicants' Preliminary Amendment filed on June 02, 2006. In virtue of this communication, claims 1-10 are canceled; claims 11-20 are newly added; thus, claims 11-20 are currently presented in the instant application.

Inventorship

2. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Priority

3. Acknowledgement is made of applicant's claim for foreign priority under 35 U.S.C. 119(a)-(d).

Information Disclosure Statement

4. The information disclosure statements (IDS) submitted on 08/15/07 and 06/02/06 in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is considered by the examiner.

If applicant is aware of any prior art or any other co-pending application not already of record, he/she is reminded of his/her duty under 37 CFR 1.97 to disclose the same.

Drawings

5. The drawing submitted on 06/02/06 is accepted as part of the formal application.

Specification

6. The specification is accepted as part of the formal application.

Applicant cooperation is requested in correcting any errors of which applicant may become aware in the specification.

Claim Rejections - 35 USC § 112

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claims 13, 15, 17 and 18 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 13, the phrase "its length" in line 2 is unclear. It is not clear what does the term "its" refer to?

Regarding claim 15, the recitation "the antenna conductors are arranged as to at least one of their length" is unclear. It is not clear what does the term "their" refers to? and how the antenna conductors are arranged as to at least one of their length and position.

Regarding 15, the phrase "a resonant behavior of the antenna" is unclear since examiner cannot determine whether "the antenna" is the "antenna conductors" in line 1 of claim 15 or the "window-integrated antenna" of claim 11.

Regarding claim 17, the phrase "their connection ends" in line 3 is unclear. It is not clear what does the term "their" refer to?

Regarding claim 18, the phrase "multiple decoupling elements for the FM reception and further decoupling elements" in line 2 is unclear. It is not clear that the "decoupling elements" in line 1 and line 2 of claim 18 are same as or different with the "at least one decoupling element in claim 1. If they are the same, it should be "said decoupling elements".

Clarification is required.

Claim Rejections - 35 USC § 102

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

10. Claims 11, 12-13, 16-17 and 19 are rejected under 35 U.S.C. 102(b) as being anticipated by Oka (US 6,215,450 B1).

Regarding claim 11, Oka discloses, in Figure 7, a window-integrated antenna for a vehicle, comprising a heating conductor field (32), which is provided for FM reception and LMS reception; and at least one decoupling element (33, 34, 35) for the FM

reception which has a high-frequency, low-resistance, and non-galvanic connection to the heating conductor field (32).

Regarding claim 12, as applied to claim 1, Oka discloses, in Figure 7, wherein the decoupling element (33) for the FM reception includes at least one conductor (33) situated essentially parallel to at least one boundary of the heating conductor field (32) which is not formed by a busbar for the heating conductor field (32).

Regarding claim 13, as applied to claim 11, Oka discloses, in Figure 7, wherein the decoupling element (33) is arranged as to at least one of its length and position so that a resonant impedance behavior occurs in the FM frequency range at its connection end.

Regarding claim 16, as applied to claim 11, Oka discloses, in Figure 7, further comprising at least one further decoupling element (34) for a different frequency range.

Regarding claim 17, as applied to claim 16, Oka discloses, in Figure 7, wherein the decoupling element (33) for the FM reception and the at least one further decoupling element (34) are galvanically connected at their connection ends.

Regarding claim 19, as applied to claim 11, Oka discloses, in Figure 7, wherein a plurality of decoupling elements (33, 34, 35) including the decoupling element for the LMS reception are connected to a shared module carrier (36).

11. Claims 11, 14-15 and 20 are rejected under 35 U.S.C. 102(b) as being anticipated by Endo et al. (US 6,201,506 B1), herein after "Endo".

Regarding claim 11, Endo discloses, in Figure 1, a window-integrated antenna for a vehicle, comprising a heating conductor field (10a), which is provided for FM

reception and LMS reception; and at least one decoupling element (20) for the FM reception which has a high-frequency, low-resistance, and non-galvanic connection to the heating conductor field (10a).

Regarding claim 14, as applied to claim 11, Endo discloses, in Figure 1, wherein antenna conductors (10b) are situated in the heating conductor field essentially perpendicularly to heating conductors (10a) of the heating conductor field and are galvanically linked to the heating conductors.

Regarding claim 15, as applied to claim 14, as best understood, Endo discloses, in Figure 1, wherein the antenna conductors (10b) are arranged as to at least one of their length and position so that a resonance behavior of the antenna occurs at a connection end of the decoupling element in the FM range.

Regarding claim 20, as applied to claim 11, Endo discloses, in Figure 1, wherein a filter element is provided in a heating current circuit.

Claim Rejections - 35 USC § 103

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over Oka (US 6,215,450 B1) in view of Kakizawa (US 5,933,118).

Regarding claim 18, Oka discloses every feature of claimed invention as expressly recited in claim 11, except for multiple decoupling elements for the FM

reception and further decoupling elements for other frequency ranges are connected to a diversity switching device.

Kakizawa discloses, in Figure 1, multiple decoupling elements for the FM reception and further decoupling elements for other frequency ranges are connected to a diversity switching device.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to include the switching device of Kakizawa in the antenna for vehicle of Oka, doing so would switch the decoupling elements one over the other (col. 1, lines 35-40).

Inquiry

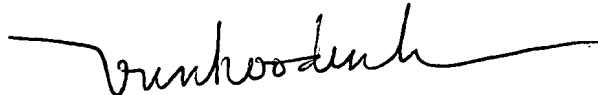
14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dieu Hien T. Duong whose telephone number is 571-272-8980. The examiner can normally be reached on Monday - Friday, from 8:30AM-5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Douglas W. Owens can be reached on 571-272-1662. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



DD
Art Unit 2821

TRINH DINH
PRIMARY EXAMINER